

REMARKS

Applicants respectfully request the Examiner to reconsider the present application in view of the following remarks.

Status of the Claims

Claims 1-2 and 6-7 are pending in the present application. In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Issues under 35 U.S.C. § 103(a)

1) The Examiner has rejected claims 1, 2, 6, and 7 under 35 U.S.C. § 103(a) as being unpatentable over Chappelow et al. '759 (US 6,610,759).

2) The Examiner has rejected claims 1, 2, 6, and 7 under 35 U.S.C. § 103(a) as being unpatentable over JP '618 (JP 5-170618) in view of Chappelow et al. '759 or Nakatsuka et al. '877 (US 6,790,877).

Applicants respectfully traverse, and reconsideration and withdrawal of these rejections are respectfully requested.

The Present Invention

The photocurable dental enamel adhesive composition (hereinafter referred to as "the present composition") is characterized in that (i) specific components (A), (B), and (C) are used and (ii) the present composition comprises components (A) to (E) including these components (A), (B), and (C) in a specific weight ratio (see claim 1).

Since the present composition has the above features (i) and (ii), as shown in Examples 1-6 of Table 1 at page 22 of the present specification, the present invention has excellent storage stability and high bonding strength.

In stark contrast, as shown in Table 1 (continued) at page 23 of the present specification, the comparative compositions, which do not have any one of the above features (i) and (ii) of the present composition, cannot obtain excellent storage stability and high bonding strength.

The composition of Comparative Example 1 has a component (A) content of 6.3 parts by weight, which is smaller than the lower limit value of the content (10 to 40 parts by weight) specified in claim 1 of the present application.

The composition of Comparative Example 2 has a component (A) content of 40.3 parts by weight, which is higher than the upper limit value of the content (10 to 40 parts by weight) specified in claim 1 of the present application, and a component (E) content of 48 parts by weight, which is lower than the lower limit value of the content (50 to 80 parts by weight) specified in claim 1 of the present application.

The composition of Comparative Example 3 does not comprise the component (B), which means that the content of the component (B) is outside of the lower limit value of the content (2 to 30 parts by weight) specified in claim 1 of the present application.

The composition of Comparative Example 4 has a component (B) content of 38 parts by weight, which is higher than the upper limit value of the content (2 to 30 parts by weight) specified in claim 1 of the present application.

The component (A) of the composition of Comparative Example 5 differs from the component (A) specified in claim 1 of the present application.

The component (B) of the composition of Comparative Example 6 differs from the component (B) defined in claim 1 of the present application.

The component (C) of the composition of Comparative Example 7 differs from the component (C) defined in claim 1 of the present application.

The above comparative compositions of Comparative Examples 1 to 7 are inferior to the present composition in any one of bonding strength and storage stability (see page 23, Table 1 (continued)).

Distinctions over the Cited Prior Art

Chappelow et al. '759 fail to disclose a combination of the above features (i) and (ii) of the present composition. Neither JP '618 nor Nakatsuka et al. '877 overcome the deficiencies of this reference.

Chappelow et al. '759 also fail to disclose that the above-described excellent storage stability and high bonding strength can be obtained from a combination of the above features (i) and (ii). As above, neither JP '618 nor Nakatsuka et al. '877 overcome the deficiencies of this reference.

Since Chappelow et al. '759 disclose MAEM and various compounds which do not belong to the component (A) in claim 1 of the present application as the acidic component, the reference does not teach that the specific compound as the component (A) in claim 1 of the present application is important to attain the above excellent effects of the present invention (see Comparative Example 5). Further, Chappelow et al. '759 fail to teach that the specific components (B) and (C) in claim 1 of the present application are also important to attain the above excellent effects of the present invention.

Relevant to this § 103(a) rejection, *Graham v. John Deere*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966) has provided the controlling framework for an obviousness analysis, wherein a proper analysis under § 103(a) requires consideration of the four *Graham* factors. One such factor includes the evaluation of any evidence of secondary considerations (e.g., commercial success; unexpected results). 383 U.S. at 17, 148 USPQ at 467. In this regard, Applicants respectfully submit that the present invention has achieved unexpected results, whereby such results rebut any asserted *prima facie* case of obviousness. See *In re Corkill*, 711 F.2d 1496, 226 USPQ 1005 (Fed. Cir. 1985). Also, the comparative showing need not compare the claimed invention with all of the cited prior art, but only with the closest prior art. See MPEP 716.02(b) and 716.02(e).

In this regard, Applicants note MPEP 2144.08(5)(B), which states that rebuttal evidence and arguments can be presented in the specification, *In re Soni*, 54 F.3d 746, 750, 34 USPQ2d 1684, 1687 (Fed. Cir. 1995).

As noted above, experimental data in the specification, as shown in Table 1, show that the present invention achieves the unexpected results of excellent storage stability and high bonding strength, as compared to the comparative examples.

Thus, due to the unexpected results as achieved by the present invention, the rejections have been overcome. Reconsideration and withdrawal of these rejections are respectfully requested.

Applicants respectfully submit that the combination of the above features (i) and (ii) of the present composition as well as the excellent effects attained thereby are not obvious over Chappelow et al. '759 alone or JP '618 in view of Chappelow et al. '759 or Nakatsuka et al. '877.

CONCLUSION

In view of the above amendment, Applicants believe the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Chad M. Rink, Reg. No. 58,258 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Dated: SEP 10 2008

Respectfully submitted, #28977

for ✓
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